

Patent
Attorney Docket No.: P10-1215.DIV

REMARKS

Rejections under 35 U.S.C § 103(a)

Claims 7-15 and 17-28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,380,294 of Babinec. Applicant claims a cross-linkable expandable blank (claims 7 and 8) and a cross-linked expanded safety support made by a claimed process that includes forming the blank (claims 10 and 11). The blank comprises both a blowing agent and water.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Applicant asserts that a *prima facie* case of obviousness has not been presented because the cited prior art fails to teach or suggest each and every limitation of the pending claims. While Babinec teaches that a blowing agent is added to the gel mix before being expanded, Babinec fails to teach or suggest that **both** a blowing agent **and** water in an amount of from 3 to 6 phr is added to an expandable blank.

Now specifically looking at independent claims 7, 8, 10 and 11, Applicant claims a blank and process that includes forming the blank having, *inter alia*, (1) a blowing agent **and** (2) water in an amount of from 3 to 6 phr. Since Babinec fails to teach or suggest adding **both** a blowing agent **and** water, Babinec fails to teach or suggest each and every limitation claimed by Applicant. Applicant respectfully asserts that the Examiner's statement that the water amount is recognized as a result-effective variable is not correct because Babinec fails to disclose not just the amount of water that should be added but that **any water** is added that is not a blowing agent.

Therefore, because the prior art fails to teach or suggest each of the limitations of Applicant's claimed invention, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 7, 8, 10 and 11 as well as the claims depending therefrom.

An additional requirement for providing a *prima facie* case of obviousness is that the Examiner must provide a basis for combining or modifying the cited references. The mere fact

Patent
Attorney Docket No.: P10-1215.DIV

that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

In the case *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002), the Federal Circuit held:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes *evidence* relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

Id. at 1343, emphasis added.

Applicant respectfully asserts that the Examiner has failed to provide the requisite evidence of a teaching or suggestion to modify the cited prior art. Specifically, the Examiner states that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the water in the range instantly claimed motivated by the desire to effect coalescing and welding of the beads to form the article." (Office Action, p. 4). However, Babinec merely teaches, as the Examiner points out on page 3 of the Office Action, that the beads may be heated with steam to effect coalescing and welding of the beads to form the article. (Babinec, col. 23, lines 21-26). This disclosure by Babinec does not teach or suggest adding water to the material – it merely teaches heating the beads with steam to effect the coalescing and welding.

Because the Examiner has failed to provide the requisite evidence relevant to a teaching or suggestion of adding water to the blank for a purpose other than as a blowing agent, Applicant respectfully asserts that a *prima facie* case of obviousness has not been presented. Reconsideration and withdrawal of the rejection of claims 7, 8, 10 and 11 is respectfully requested as well as for the claims depending therefrom.

The Examiner also has rejected independent claims 10 and 11 as being product-by-process claims that result in a product that is similar to the product disclosed by Babinec. As the Examiner has stated, if the product-by-process claim is the same as or obvious from a product of the prior art, then the claim is unpatentable even though the prior product is made by a different process.

Patent
Attorney Docket No.: P10-1215.DIV

The courts have provided that after “the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 291 (Fed. Cir. 1983). Applicant respectfully asserts that the Examiner has not shown that the claimed product appears to be the same or similar to that of the prior art. Therefore, the burden has not shifted to Applicant to produce evidence establishing an unobvious difference between the claimed product and the prior art product.

First, as pointed out above, the prior art product blank does not contain both water and a blowing agent. Second, Babinec fails to disclose a safety support or any product similar to a safety support having a cellular structure comprising closed cells. As noted in *Morosi*, the Examiner must first show that the claimed product appears to be the same or similar to that of the prior art.

The Examiner states that “the tire of Babinec is identical to or only slightly different than the claimed article.” (Office Action, p. 4). Applicant respectfully disagrees because (1) Babinec fails to disclose a foamed tire and (2) Applicant does not claim a foamed tire but instead claims a **safety support** capable of being mounted on a wheel *within a tire*.

Babinec discloses that the composition disclosed therein can be molded into different articles through several different molding processes including casting from solution, thermoforming, various injection molding processes and blow molding processes, and profile extrusion, sheet extrusion, film casting, coextrusion and multilayer extrusion, coinjection molding lamination and film blowing. (Babinec, col. 21, lines 38-50). Therefore, Babinec discloses that the composition he discloses can be formed into foamed and unfoamed articles.

Babinec then discloses an entire list of examples of articles that can be made with foam. (Babinec, col. 26, line 45 through col. 27, line 5). Babinec then discloses that “in addition to foams, the compositions of the present inventions find utility in . . . transportation applications, including but not limited to . . . tires. (Babinec, col. 27, lines 5-22).

Therefore, the tire disclosed by Babinec is **not** made of a foamed material but is instead made of a material that is **not foamed**. Because Babinec does not disclose any product similar to that disclosed by Applicant, Applicant respectfully asserts that the *prima facie* case of obviousness of a product-by-process claim has not been presented. Reconsideration and

Patent
Attorney Docket No.: P10-1215.DIV

withdrawal of the rejection of claim 10 and 11 is requested as well as for all claims that depend therefrom.

Claims 7, 8, 10-13, 17-20 and 24-28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/37517 issued to Arai, *et al.* and published June 29, 2000. U.S. Patent No. 6,559,234 of the same inventors is relied upon as an equivalent of the cited prior art for convenience.

The present application is a divisional application of U.S. Patent No. 6,673,848 filed April 25, 2001, which claims priority from the French Application 00/05346 filed April 25, 2000. (See Filing Receipt). Because the present application claims priority to a date prior to the date of publication of the cited prior art, Applicant respectfully asserts that the cited art is not properly prior art.

Applicant is preparing a certified translation of the French application and will file the translation as soon as it is received. Reconsideration and withdrawal of the rejection of independent claims 7, 8, 10 and 11 is requested as well as for all claims depending therefrom.

Applicant respectfully asserts that all claims are now in condition for allowance and requests the timely issuance of the Notice of Allowance. If the Examiner believes that a telephone interview would expedite the examination of this pending patent application, the Examiner is invited to telephone the below signed attorney at the convenience of the Examiner. In the event there are any fees or charges associated with the filing of these documents, the Commissioner is authorized to charge Deposit Account No. 13-3085 for any necessary amount.

Respectfully submitted,

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